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10/730,459

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Mark J. Levine

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EXAMINER

PIZIALI, ANDREW T

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

01/08/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/730,459 | Applicant(s) LEVINE ET AL. | |
| | Examiner Andrew T. Piziali | Art Unit 1794 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-13, 24, 28, 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/14/04 & 3/23/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/3/2008 has been entered.

Election/Restrictions

2. Newly amended claims 1-13 are directed to an invention that is independent or distinct from the invention originally elected for the following reason: The applicant elected Group I, drawn to a hydroentangling support fabric, without traverse in the reply filed 10/21/2005. The elected invention and newly amended claims 1-13 are related as subcombination and combination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, for example, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require that the flat filaments are incorporated into the support fabric during production of the support fabric. The subcombination has separate utility such as a transfer belt or as a support fabric in a non-hydroentangling apparatus. Accordingly, claims 1-13 are withdrawn from consideration as at least being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. It is noted that claims 3, 5 and 9-12 are also drawn to non-elected species.

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Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 23 and 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claimed support fabric is in a continuous loop or made endless. The claims are indefinite because the distinction between a continuous loop fabric and an endless fabric is unclear.

Claim Rejections - 35 USC § 102/103

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 23 and 25-27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 5,857,497 to Gaisser.

Gaisser discloses a support fabric comprising flat filaments and wherein said support fabric is endless (see entire document including column 4, lines 30-39 and column 6, lines 42-50).

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Although Gaisser does not specifically mention using the fabric as claimed, but it appears that the fabric is capable of being used as claimed. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Gaisser does not appear to specifically mention when in the process the filaments are incorporated into the support fabric, but absent a showing to the contrary, it is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article because the end result is a fabric comprising flattened filaments.

Claim Rejections - 35 USC § 103

8. Claims 23 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,142,752 to Greenway in view of USPN 4,345,730 to Leuvelink.

Greenway discloses hydroentangling devices in combination with endless conveyor belts (see entire document including column 4, lines 33-46 and Figure 1). Greenway is silent with regards to specific conveyor belt materials, therefore, it would have been necessary and thus obvious to look to the prior art for conventional conveyor belt materials. Leuvelink provides this conventional teaching showing that it is known in the conveyor belt art to use a fabric comprising flat filaments (see entire document including column 4, line 63 through column 5, line 23). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the endless conveyor belts from the flat filament fabric of Leuvelink, motivated by the expectation of successfully practicing the invention of Greenway

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and because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

Although Leuvelink does not specifically mention using the fabric as claimed, but it appears that the fabric is capable of being used as claimed. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Leuvelink does not appear to specifically mention when in the process the filaments are incorporated into the support fabric, but absent a showing to the contrary, it is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article because the end result is a fabric comprising flattened filaments.

9. Claims 23 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,883,022 to Elsener in view of any one of USPN 3,884,630 to Schwartz or USPN 4,104,814 to Whight.

Elsener discloses a fabric comprising flat filaments (see entire document including column 3, lines 40-47). Elsener discloses that the fabric is preferably a roller hand towel (column 3, lines 56-62). Elsener does not appear to specifically disclose that the roller hand towel is in a continuous loop or made endless, but Schwartz and Whight each disclose that it is known in the roller hand towel art to use an endless fabric (see entire documents including column 1, lines 4-23 and column 2, lines 43-45 of Schwartz and column 1, lines 4-45 of Whight). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the fabric in any suitable shape, such as an endless fabric, because it

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is within the general skill of a worker in the art to select a known shape on the basis of its suitability and desired characteristics.

Elsener does not specifically mention using the fabric as claimed, but it appears that the fabric is capable of being used as claimed. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Elsener discloses that the filaments of the fibers may be rectangular (flat) prior to weaving the fabric (column 3, lines 40-47). Absent a showing to the contrary, it is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article.

Response to Arguments

10. Applicant's arguments filed 10/3/2008 have been fully considered but they are not persuasive.

Regarding the 35 USC 112 rejection, the applicant asserts that page 7, line 24 to page 8, line 7 of the current specification demonstrates the difference between a support fabric in a continuous loop and a support fabric made endless. The examiner respectfully disagrees. The cited section of the current specification refers to "endless weaving" while the current claims simply refer to a support fabric "made endless." Therefore, applicant's argument is not commensurate in scope with the current claims.

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The applicant asserts that the fabric disclosed by Gaisser fails to teach or suggest the claimed support fabric because the support fabric of the current invention requires particulars mentioned in the specification. The examiner respectfully disagrees. The features upon which applicant relies (i.e., permeability and reflectivity) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant asserts that Greenway does not use the fabric in a hydroentangling apparatus. The examiner respectfully disagrees. Greenway discloses that the fabric is used in an apparatus comprising hydroentangling modules (column 4, lines 33-46).

The applicant asserts that there is no motivation to combine the teachings of Greenway with the teachings of Leuvelink. The examiner respectfully disagrees. Greenway is silent with regards to specific conveyor belt materials, therefore, it would have been necessary and thus obvious to look to the prior art for conventional conveyor belt materials. Leuvelink provides this conventional teaching showing that it is known in the conveyor belt art to use a fabric comprising flat filaments (see entire document including column 4, line 63 through column 5, line 23). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the endless conveyor belts from the flat filament fabric of Leuvelink, motivated by the expectation of successfully practicing the invention of Greenway and because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

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In response, the applicant asserts that Greenway discloses the use of round filaments. The examiner respectfully disagrees. Greenway completely fails to mention round filaments. In addition, even if Greenway did mention round filaments, which he does not, it still would have been obvious to use flat filaments because it has been held to be within the general skill of a worker in the art to select a known material (flat or round filaments) on the basis of its suitability and desired characteristics.

The applicant asserts that the fabric of Elsener has nothing to do with industrial process fabrics and therefore the applied prior art fails to render the current claims obvious. The examiner respectfully disagrees. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T. Piziali whose telephone number is (571) 272-1541. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew T Piziali/

Primary Examiner, Art Unit 1794